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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,062	02/25/2004	Kazunori Yasuda	81880.0115	9539

26021 7590 04/05/2007  
HOGAN & HARTSON L.L.P.  
1999 AVENUE OF THE STARS  
SUITE 1400  
LOS ANGELES, CA 90067

EXAMINER
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MILLER, CHERYL L

ART UNIT	PAPER NUMBER
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3738

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/05/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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<b>Office Action Summary</b>	Application No. 10/787,062	Applicant(s) YASUDA ET AL.	
	Examiner Cheryl Miller	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 January 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 9 is/are allowed.
- 6) ☒ Claim(s) 2-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

Claims 2-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 4 recites, "wherein an anterior edge of the sectional circular arc portion at the anterior side of the lateral sliding surface is positioned at the femoral component side to an extending line from the linear portion out the posterior side(s) in the anterior-to-posterior direction thereof." This statement is unclear and indefinite and further was not found to be found by the examiner in the specification, thus is being considered new matter. Claims 2-3 and 5-8 depend upon claim 4 and inherit all problems associated with the claim.

Claim 5 and all its limitations were not found in the specification and is being considered new matter as well.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites, "wherein an anterior edge of the sectional circular arc portion at the anterior side of the lateral sliding surface is positioned at the femoral component side to an extending line from the linear portion to the posterior side(s) in the anterior-to-posterior direction thereof." This statement is unclear and indefinite. It is unclear what the applicant is trying to claim. Claims 2-3 and 5-8 depend upon claim 4 and inherit all problems associated with the claim.

Claim 4 recites the limitation "the femoral component side" in line 11. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "the circular arc" in line 4. There is insufficient antecedent basis for this limitation in the claim. Several circular arcs have been claimed, it is unclear which arc the applicant is referring to.

Claim 5 recites the limitation "the femoral component side" in line 3. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 4-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Otto et al. (US 2004/0243244 A1, cited previously). Referring to claim 4, Otto discloses an artificial knee joint (see figs.4-11, 23-24) comprising a femoral component (200) and a tibial component (400), the tibial component having an inner/medial sliding surface (440) having a circular arc shape in the front and rear (anterior and posterior) extending in the anterior posterior direction (seen clearly in fig.4), and an outer/lateral sliding surface (442) having a circular arc shape in the front (anterior) and linear in the rear (posterior) in the anterior posterior direction (straight slope, see fig.4; P0103, P0105). Otto has shown anterior lateral side more superior than lateral posterior side (see 444, fig.4). Otto discloses the lateral side anterior to be concave (see fig.4). Otto discloses a tray and insert (see fig.1A) for the tibial component, wherein the lateral anterior side is thicker than the lateral posterior side (fig.4, line 444).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Otto et al. (US 2004/0243244 A1, cited previously) in view of Roger (US 5,935,173, cited previously). Otto discloses a knee joint substantially as claimed (see above). Otto discloses a tibial component (400) having an outer/lateral sliding surface (442) that is circular on the anterior end and linear on the posterior end (fig.4). Otto also has shown an inner/medial sliding surface (440) that

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appears in the figures (fig.4-11) to be circular on the anterior and posterior ends and linear in the center, however Otto is silent to recite and exact curvatures for the inner/medial sliding surface. Roger teaches in the same field of knee joints, a tibial component having an inner/medial sliding surface (21) with two circular ends (22, 23) with *a linear segment* (24) inbetween, for the purpose of allowing *better congruency with the femoral component through the full range of flexion and extension* (col.5, lines 5-32). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine Otto's tibial component with the seemingly claimed curvature seen in Otto's figures, with Roger's teaching of specific curvatures, particularly a linear segment inbetween two curves, in order to provide a sliding surface having better congruency with the femoral component through the full range of flexion and extension.

In the alternative to the above rejections, claims 2 and 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roger (US 5,935,173, cited previously) in view of Otto et al. (US 2004/0243244 A1, cited previously). Roger discloses an artificial knee joint (10) comprising a femoral component (11) and a tibial component (13; see fig.5), the tibial component having an inner/medial sliding surface (21) and an outer/lateral sliding surface (other 21) each having circular arc from anterior to posterior (and a mid linear segment; col.5, lines 5-32). Roger does not however disclose the outer/lateral sliding surface to have a rear/posterior linearity. Otto teaches in the same field of artificial knee joints, modification of the *outer/lateral* sliding surface (442) to have a rear/posterior linearity (straight slope, P0103, fig.4) in order to provide the advantage of increase movement/rotation (P0103). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine Roger's tibial component having two sliding surfaces that are curved, with Otto's teaching of modifying the

outer/lateral sliding surface to have a rear linearity, in order to provide a tibial component having increased movement/rotation.

*Allowable Subject Matter*

Claims 1 and 9 are allowed.

Claim 3 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

*Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (571) 272-4755. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4755. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cheryl Miller



**CORRINE McDERMOTT**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**